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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,192	09/17/1999	JOHN WANKMUELLER	AP31994-0704	1972

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/399,192	WANKMUELLER ET AL.	
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-29, 33-45, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-29, 33-45, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Request for Reconsideration

1. This is in response to a request for reconsideration file May 31st, 2005. Claims 1-13, 17-29, 33-45, 49 and 50 are being reconsidered in this action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13, 17-29, 33-45, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush et al (U.S. Patent No. 5,263,162) in view of Korman et al (U.S. Patent No. 6,308,887).

Re claim 1: Bush et al discloses a method for generating identification data (*deriving CGPIN*), comprising providing (*read*) an ATM PIN (*pin code*) related to a first transaction type; and performing a cryptographic operation (*perform encryption*) upon an ATM PIN (*PIN code*) thereby generating (*derive*) a non ATM PIN (*CGPIN*) for use in a second transaction which is a non ATM transaction (*comparing and matches*) (*see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15*). Bush et al fail to teach an inventive concept where a non-electronic commerce PIN is to be entered by the user. However, Korman et al teach an inventive concept where a non-electronic commerce PIN is to be entered by the user (*see abstract, column 4 lines 50-col. 5 line 37*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify the inventive concept of Bush et al to include Korman et al's inventive concept where a non-electronic commerce PIN is to be entered by the user because this would have provided a user access to electronic financial transactions, rather than restricting electronic transactions only to those with credit cards. A user can complete a variety of transactions electronically. For example, purchase of airline tickets could now be accomplished without the use of a credit card.

Re claim 2: Bush et al further discloses that the step of performing a cryptographic operation comprises providing a conversion key (*pseudo-random number*) and using the conversion key to perform said cryptographic operation upon an ATM PIN (*see column 2 lines 21-42*).

Re claim 3: Bush et al further discloses that the step of providing a conversion key comprises: providing conversion key derivation data (i.e., PAN) providing a conversion key derivation key and performing the cryptographic operation upon the conversion key derivation data and the conversion key derivation key (*see column 2 lines 21-42*).

Re claim 4: Bush et al further discloses that the step of performing a cryptographic operation upon the conversion key derivation data and the conversion key derivation key comprises using the conversion key derivation key to perform at least one cryptographic operation upon the conversion key derivation data (*see column 2 lines 21-42*).

Re claim 5: Bush et al further discloses that the conversion key derivation data includes an identification number that is associated with multiple accounts, and wherein at least one cryptographic operation using a secret key is performed to cryptographically process said conversion key derivation data to produce the conversion key (*see column 2 lines 21-42*).

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Re claim 6: Bush further discloses that the step of performing a cryptographic operation comprises: providing cryptographically-computed data and performing an operation upon an ATM PIN and the cryptographically-computed data (*see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15*).

Re claim 7: Bush further discloses that the step of providing cryptographically-computed data comprises: providing initial data and performing at least one cryptographic operation using a secret key upon the initial data thereby producing the cryptographically-computed data (*see column 2 lines 21-42*).

Re claim 8: Bush disclose that the at least one cryptographic operation using a secret key comprises at least one of a DES-encryption and a DES-decryption (*see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15*).

Re claim 9: Bush further discloses that least a portion of the initial data is obtained from at least a portion of an account number (*see column 2 lines 21-42*)

Re claims 10 and 13: Bush disclose that the operation upon an ATM PIN and the cryptographically-computed data comprises either a subtraction operation or an addition operation (*see abstract, 5-7, column 3 lines 16-45, 4 lines 42-5 line 15*)

Re claim 11 and 12: Bush further discloses that the step of providing cryptographically computed data further comprises generating a cryptographically-computed number having a base corresponding to a base of a number representing the first set of identification data, wherein said cryptographically-computed number has a number of digits corresponding to a number of digits of said number representing an ATM PIN (*see column 2 lines 21-42*).

Re claims 17-29, 33-45, 49 and 50: The claimed system would have been inherent to perform the method disclosed by Bush et al as stated above. Therefore, they are rejected under the same rationale.

Response to Arguments

4. Applicant's arguments filed May 31st, 2005 have been fully considered but they are not persuasive.

a. Applicant argue that it would be improper to combine the inventive concept of Bush and Korman since the system are incompatible and not combinable. Examiner respectfully disagrees with Applicant characterization of the combined prior art. Examiner asserts Korman teach user entering a non-ATN electronic commerce PIN by the user. It is indeed true that the system in Bush allows the creation and transmission of CGIPIN. Bush system also allow user to enter PIN. The claimed inventive concept calls for the creation of a non-ATN electronic commerce PIN to be provided to the user and the user then entered the created electronic PIN in a second transaction. According to the claim 1, the user enter the non-ATM electronic PIN. Therefore, since the inventive concept of Korman allows a user to enter a non-electronic commerce PIN in a transaction and Bush system also allows user to enter PIN, the system are combinable. Furthermore, take note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Also it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

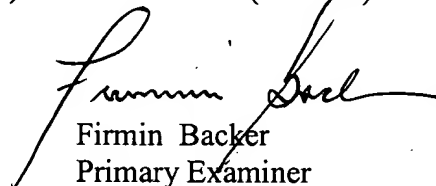
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Backer
Primary Examiner
Art Unit 3621

July 26, 2005